



Docket No.: 206253US-3PCT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

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RE: Application Serial No.: 09/830,560
Applicants: Nichimu INADA et al.
Filing Date: MAY 7, 2001
For: MASSAGING APPARATUS
Group Art Unit: 3764
Examiner: J. Yu

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SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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10-202
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Atty. Docket No.: 206252US-3PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF :
Nichimu INADA et al. : GROUP ART UNIT: 3764
SERIAL NO: 09/830,560 : EXAMINER: J. YU
FILED: MAY 7, 2001 :
FOR: MASSAGING MACHINE :

PROVISIONAL ELECTION

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SIR:

In response to the Restriction/Election of Species Requirement mailed on August 27, 2002, Applicants provisionally elect, with traverse, Group I, claims 39-73, and Species I drawn to an optical sensor and identify claims 30, 40, 41, 42, 43, 48, 49, 50, and 51 as being readable on the provisionally elected species.

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In addition to making this election, Applicants respectfully traverse both the Restriction Requirement and the Election of Species requirement as being improper.

With respect to the Restriction Requirement, the Office Action alleges that there are four (4) inventions with Groups I, II, III, and IV all being drawn to a massaging apparatus, as follows:

Group I, claims 39-73, drawn to a massaging apparatus;
Group II, claims 74-79, drawn to an massaging apparatus including a control element and a memory for storing the position of the therapeutic member;

Group III, claims 80-83, drawn to a massaging apparatus having an air cell, and a detecting means for detecting inflation and deflation of the air cell; and **Group IV**, claims 84-91, drawn to a massaging apparatus having a detector for detecting a load.

Applicants respectfully submit that the inventions of Groups I, II, III, and IV are all one invention (i.e. a massaging apparatus), but that the massaging apparatus is simply claimed in varying manner and scope as is allowed by the U.S. patent practice.

In addition, the outstanding Restriction Requirement merely includes the conclusory statement that the application contains inventions or groups of inventions "which are not so linked as to form a single general inventive concept under PCT Rule 13.1."

The Restriction Requirement then goes on to state, as follows:

The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: each Group has a different mode of operation.

First, Applicants respectfully submit that whether or not the invention of Groups I, II, III, and IV have a different mode of operation is immaterial and has nothing to do with the special technical feature of the claims referred to in PCT Rules 13.2.

In addition, Applicants respectfully submit that PCT Rule 13, entitled "Unity of Invention," states, as follows:

13.1 *Requirement*

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

13.2 *Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled*

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among

those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Applicants also respectfully submit that the Restriction Requirement has failed to indicate why the present application lacks unity of invention because the Restriction Requirement has not pointed out any special technical feature present in any one of the groups of invention that is not shared by the other groups of the invention. Thus, the Restriction Requirement does not indicate, as is required by PCT Rules 13.1 and 13.2, the differences in special technical features between the claimed inventions.

Further, PCT Rules 13.1 and 13.2 require that in order to restrict, lack of unity of invention must be shown, and in order to show lack of unity of invention the Restriction Requirement must point out at least one special technical feature of the claims relating to one of the groups of inventions that is not a special technical feature of the remaining groups. The present Restriction Requirement fails to point out any special technical feature of any of the claims and fails to identify a specific special technical feature present in the claims of one of the groups of the present invention and not present in the claims of the other groups of the present invention. Therefore, the present Restriction Requirement fails to satisfy PCT Rules 13.1 and 13.2.

With respect to the Election of Species Requirement, Applicants respectfully submit U.S. Patent and Trademark Office practice requires an Election of Species Requirement under the PCT Rules to identify claims that correspond to the species and that this has not been done.

Rather, the Election of Species Requirement alleges that the application "contains claims directed to more than one species of the generic invention in Group I," and that these

species "lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1." The Election of Species Requirement then goes on to allege that the structural feature of the massaging apparatus of the present invention represented by the generic term "pivotal-position-detecting-sensors," but implemented as differing types of sensors, must be divided into species, as follows:

an optical sensor represents Species I;
a limit switch represents species II;
a lead switch represents Species III;
a variable resistor represents species IV; and
a sensor comprising a magnetoelectric converting element represents Species V.

Applicants respectfully submit that these alleged species are different types of the generic term "pivotal-position-detecting-sensors" which is a structural feature of the massaging apparatus of the present invention and thus there is a single general inventive concept (i.e., a massaging apparatus having a "pivotal-position-detecting-sensors," even though the "pivotal-position-detecting-sensors" takes on the different forms of an optical sensor, a limit switch, a lead switch, a variable resistor, and a sensor comprising a magnetoelectric converting element).

The Election of Species Requirement also alleges that the species "do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical feature for the following reason: the different species have different modes of operation." Applicants respectfully submit that whether or not the invention of Species I, II, III, IV, and V have a different mode of operation is immaterial and has nothing to do with the special technical feature of the claims referred to in PCT Rules 13.2.

Applicants also respectfully submit that the Restriction Requirement has failed to indicate why the present application lacks unity of invention because the Restriction Requirement has not pointed out any special technical feature present in any one of the groups of invention that is not shared by the other groups of the invention. Thus, the Restriction Requirement does not indicate, as is required by PCT Rules 13.1 and 13.2, the differences in special technical features between the claimed inventions.

PCT Rules 13.1 and 13.2 require that in order to restrict, lack of unity of invention must be shown, and in order to show lack of unity of invention the Restriction Requirement must point out at least one special technical feature of the claims relating to one of the species of inventions that is not a special technical feature of the remaining species. The present Election of Species Requirement fails to point out any special technical feature of any of the claims and fails to identify a specific special technical feature present in the claims of one of the species of the present invention which is not present in the claims of the other species of the present invention. Therefore, the present Restriction Requirement fails to satisfy PCT Rules 13.1 and 13.2.

Further, Applicants respectfully submit that the claims all share the special technical feature of a “pivotal-position-detecting-sensor” and the fact that this “pivotal-position-detecting-sensor” takes on different forms is not enough to require Election of Species under the PCT Rules.

In this particular case, since Applicants are at a loss as to the basis of the Election of Species Requirement, in view of the fact that the Election of Species Requirement does not state any analysis on how the species were decided, Applicants respectfully request that the Election of Species Requirement be withdrawn, or at the very least, that a new Official Action

be mailed stating the basis for the Election of Species Requirement and remedying the deficiencies above-noted, so that Applicants can then appropriately respond on the merits of the requirement.

Based on the foregoing, Applicants respectfully request that prosecution of the merits proceed on all of claims 39-99.

Respectfully submitted,

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